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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,200	04/04/2001	Richard K. Tam	M-9128 US	5368
24251	7590	03/31/2004	EXAMINER	
SKJERVEN MORRILL LLP 25 METRO DRIVE SUITE 700 SAN JOSE, CA 95110			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,200

Applicant(s)

TAM ET AL.

Examiner

Matthew s Gart

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Claim Objections*

Claims 1-24 are objected to because of the following informalities:

Claim 1 (line 4, page 22 of the patent as originally filed) recites,  
"Information about at least one product or service (hereinafter "item") offered for..."  
The use of "(hereinafter 'item')'" is not proper and creates insufficient antecedent basis for the term "item" in the duration of the dependent claims.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

**Claims 1-43 are rejected under 35 U.S.C. 102(a) as being anticipated by ThomasRegister (PTO-892, Ref U).**

Referring to claim 1. ThomasRegister discloses a method for building a catalog, comprising:

- Receiving a plurality of documents from sellers, each document including information about at least one item offered for sale (page 12, "SoluSource

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organizes information from more than 16,000 product catalogs and thousands of manufacturers-and makes it available to engineers using a proprietary, patent-pending, intelligent search engine.”) and a business rule governing sale of the item (page 10, “The advent of custom e-catalogs allows participating manufacturers with distributors to receive and manage orders and define their own business rules.”);

- Generating a catalog containing at least a group of said documents (page 11);
- Wherein a document from the plurality of documents received from the seller is included in the catalog if at least a portion of the information or the business rule meets a predetermined criterion (page 11); and
- Distributing the catalog to a plurality of buyers (page 11).

Referring to claim 2. ThomasRegister further discloses a method wherein at least one of the plurality of documents from the sellers is an XML document and the information and the business rule of the item are identified by XML tags (page 1).

Referring to claim 3. ThomasRegister further discloses a method wherein said generating the catalog comprises creating an online catalog received by the buyers via a network (page 1).

Referring to claim 4. ThomasRegister further discloses a method wherein said creating the online catalog comprises applying a template to at least the document (page 3 through page 7).

Referring to claim 5. ThomasRegister further discloses a method wherein said generating the catalog comprises creating an electronic catalog from the group of

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documents and saving the electronic catalog on computer disks distributed to the plurality of buyers (page 7, "All information supplied for publication is subject to editing, and may be published on the Internet, in book form, on CD-ROM, or in any medium or format deemed appropriate by Thomas Publishing Company.").

Referring to claim 6. ThomasRegister further discloses a method wherein said creating comprises applying a template to at least the document (page 3 through page 7).

Referring to claim 7. ThomasRegister further discloses a method wherein said generating the catalog comprises creating a paper catalog (page 7, "All information supplied for publication is subject to editing, and may be published on the Internet, in book form, on CD-ROM, or in any medium or format deemed appropriate by Thomas Publishing Company.").

Referring to claim 8. ThomasRegister further discloses a method wherein said creating comprises applying a template to at least the document (page 3 through page 7).

Referring to claim 9. ThomasRegister further discloses a method comprising sending a computer program for authoring the document to a seller (page 3 through page 7).

Referring to claim 10. ThomasRegister further discloses a method comprising sending another document from the plurality of documents to another party for inclusion in another catalog (page 3 through page 7).

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Referring to claim 11. ThomasRegister further discloses a method comprising adding additional information or adding an additional rule prior to generating the catalog (page 10 and page 11).

Referring to claim 12. ThomasRegister further discloses a method wherein the additional information includes an identifier of a cross-promoted item (page 10 through page 15).

Referring to claim 13. ThomasRegister further discloses a method wherein the additional information includes additional description of the item (page 10 through page 15).

Referring to claim 14. ThomasRegister further discloses a method wherein the business rule includes a method for determining a discount (page 10 and page 11).

The Examiner notes, the “discount” qualifies as descriptive material since it is directed to the information content of what is determined, not any specific structure or step. Regarding how this descriptive material is being used, this step is one of “determining”. The “determining” does not process the information contained in the “discount” since the “determining” is not recited as being responsive to or dependent on the format or content of the “discount”. The information content being determined is not related to how the step is performed and appears to be nonfunctional descriptive material and is given little patentable weight.

Referring to claim 15. ThomasRegister further discloses a method wherein the business rule includes at least one identifier of a component of the item (page 10 and page 11).

Referring to claim 16. ThomasRegister further discloses a method wherein the document further includes additional information about the component and an additional business rule governing the sale of the component (page 10 and page 11).

Referring to claim 17. ThomasRegister further discloses a method wherein the business rule includes an identifier of the seller (page 10 and page 11).

Referring to claim 18. ThomasRegister further discloses a method wherein the business rule includes a date on which the seller created the first document (page 10 and page 11).

Referring to claim 19. ThomasRegister further discloses a method wherein the additional rule includes an identifier of a party that received the document (page 10 and page 11).

Referring to claim 20. ThomasRegister further discloses a method wherein the additional rule further includes a date on which a party received the document (page 10 and page 11).

The Examiner notes, the "date" qualifies as descriptive material since it is directed to the information content of what is included, not any specific structure or step. Regarding how this descriptive material is being used, this step is one of "inclusion". The "including" does not process the information contained in the "date" since the "including" is not recited as being responsive to or dependent on the format or content of the "date". The information content being included is not related to how the step is performed and appears to be nonfunctional descriptive material and is given little patentable weight.

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Referring to claim 21. ThomasRegister further discloses a method comprising receiving payment from a seller when a buyer purchases an item from the catalog (page 10 through page 15).

Referring to claim 22. ThomasRegister further discloses a method wherein said generating the catalog includes creating legally binding offers with words of commitment to sell and specific terms from the business rules (page 10 and page 11).

Referring to claims 25-31. Claims 25-31 are rejected under the same rationale as set forth above in claims 1-22.

Referring to claims 32-36. Claims 25-31 are rejected under the same rationale as set forth above in claims 1-22.

Referring to claims 37-41. Claims 25-31 are rejected under the same rationale as set forth above in claims 1-22.

Referring to claims 42-43. Claims 25-31 are rejected under the same rationale as set forth above in claims 1-22.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dan, U.S. Patent Application Publication No. 2002/0138370, September 26, 2002, discloses a method and apparatus for meta-shopping and dynamic setup of B2B e-commerce.



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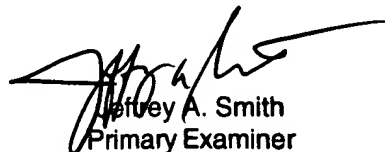
Beran, U.S. Patent Application Publication No. 2002/0055888A1, May 9, 2002, discloses an Internet based commerce system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
March 24, 2004

  
Jeffrey A. Smith  
Primary Examiner